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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/522,434	03/09/2000	Feng-Nien Ko	11544-003001	3204

7590 08/27/2002
Eric L Prahl
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Boston, MA 02110-2804

EXAMINER

COE, SUSAN D

ART UNIT	PAPER NUMBER
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1651

DATE MAILED: 08/27/2002

16

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/522,434

Applicant(s)

KO ET AL.

Examiner

Susan Coe

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 June 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3-5, 7-9 and 11-22 is/are pending in the application.
- 4a) Of the above claim(s) 3-5, 7-9 and 12-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. The amendment filed June 5, 2002, has been received and entered. The text of those sections of Title 35, U.S. Code, not included in this action can be found in a prior Office action.
2. Claims 1, 3-5, 7-9, and 11-22 are pending.

Election/Restrictions

3. As stated on page 2 of the previous Office action, in Paper No. 7, dated March 14, 2001, applicants elected without traverse of Group, claims 1-11, and the extraction procedure of claim 3 (extraction with a solvent having a polarity higher than 0.88). In response to the Office action of August 28, 2001, applicant effectively cancelled the elected species with the amendments to claim 1. Thus, in accordance with MPEP section 803.02, the new species selected for examination is the extraction procedure claimed in claim 1.
4. Claims 3-5, 7-9, and 12-22 are withdrawn from consideration as being drawn to non-elected invention and species.
5. Claims 1 and 11 are examined on the merits.

Claim Rejections - 35 USC § 102

6. Claims 1 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by US Pat. No. 4,795,742 for the reasons set forth on page 3 of the previous Office action.

All of applicant's arguments regarding this ground of rejection have been fully considered but are not persuasive. Applicant argues that US '742 does not teach that all of the American ginseng extract components have a molecular weight greater than 1,000. Based on

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this, applicant argues that US '742 does not teach the claimed invention because the claims require that all of the extract components have a molecular weight of greater than 1,000.

However, applicant's claims use the open transitional phrase "comprising." Due to this open language, applicant's composition can contain additional elements. Since the reference does teach a ginsenoside compositions that have a molecular weight greater than 1,000, the reference is still considered to teach the claimed composition.

7. Claims 1 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Derwent English abstract of JP 04316507 A for the reasons set forth on pages 3 and 4 of the previous Office action.

All of applicant's arguments regarding this ground of rejection have been fully considered but are not persuasive. Applicant argues that JP '507 does not teach the claimed composition because it teaches components that have a molecular weight of at least 10,000, not 1,000 as claimed by applicant. However, applicant's claims only require a component that has a molecular weight that is greater than 1,000. Therefore, the component of JP '507 that is 10,000 MW or greater meets this limitation. Applicant has not claimed a upper limitation on molecular weight.

8. Claims 1 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by English abstract of JP 61109732 A for the reasons set forth on page 4 of the previous Office action.

All of applicant's arguments regarding this ground of rejection have been fully considered but are not persuasive. Applicant argues that JP '732 does not teach the claimed composition because it teaches components that have a molecular weight of at least 100,000, not 1,000 as claimed by applicant. However, applicant's claims only require a component that has a

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molecular weight that is greater than 1,000. Therefore, the component of JP '732 that is 100,000 MW or greater meets this limitation. Applicant has not claimed a upper limitation on molecular weight.

9. No claims are allowed.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Coe whose telephone number is (703) 306-5823. The examiner can normally be reached on Monday to Thursday from 8:00 to 5:30 and on alternating Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Wityshyn, can be reached on (703) 308-4743. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3014.

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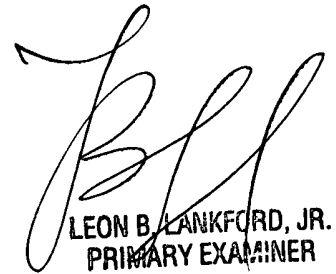
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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

SDC

August 23, 2002



LEON B. LANKFORD, JR.
PRIMARY EXAMINER